REMARKS

This amendment is submitted in response to the Office Action mailed on January 11, 2006. As a result, claims _____are pending. Of these, claims 1-10, 13-15, 30, and 33 stand rejected.

Although applicant addresses the rejections as follows, it also reserves all applicable rights not exercised in connection with this response, including, for example, the right to swear behind one or more of the cited references, the right to rebut any tacit or explicit characterization of the references, and the right to rebut any asserted motivation for combination. Applicant makes no admission regarding the prior art status of the cited references, regarding them as being only of record.

Unacknowledged Information Disclosure Statement

Applicant submitted an Information Disclosure Statement and a Form 1449 on December 14, 2001. However, applicant has not received any indication that the Statement has been fully considered as desired.

Accordingly, applicant respectfully requests that an initialed copy of the Form 1449 be returned to applicant's representatives to indicate that the cited references have been considered by the Examiner. A copy of the Form 1449 is provided herewith for the Examiner's convenience.

Response to §101 Rejections

Claim 14 was rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. In response, applicant submits respectfully that claim 14 addresses a system comprising several elements, each of which is cast in terms of means-plus-function language, which are to be interpreted under 35 U.S.C. 112, paragraph 6. As such, each claimed element has a scope dependent on the specific structure disclosed in the applications for accomplishing those functions. Among the various structures disclosed is computer 110 including processor 118 and software 120.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the §101 rejection.

Response to §102 Rejections

The Examiner rejected claim 34 under 35 U.S.C. §102(e) for anticipation by Wanderski (U.S. Patent 6,519,617), specifically citing column 4, lines 25-42 and column 11, lines 60-67.

In response, applicant submits respectfully that it does not appear that one of skill would recognize these passages as meeting all the precise terms of claim 34.

For example, claim 34 recites "outputting a second document comprising the disambiguated first portion of the document and the second portion of the first document." In contrast, the thrust of the cited passages appears to be that Wanderski is dynamic and highly capable and can therefore process an entire document on the fly. Applicant found no indication in these passages that Wanderski would perform a partial disambiguation.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the rejection under §102.

Response to §103 Rejections Based on Wanderski

The Examiner rejected claims 1-10 and 13-15 under 35 U.S.C. § 103(a) as being unpatentable over Wanderski. (U.S. Patent No. 6,519,617), conceding that Wanderski fails to teach "selection based upon scoring of candidate paths," but arguing that because Wanderski "incorporates a form of tallying for statistical purposes, it would have been obvious "to keep score of the nodes so as to provide the benefit of streamlining the DOM tree for a more compact document."

In response, applicant submits respectfully the Action fails to set forth a prima facie case of obviousness. First, even if the Examiner were correct and Wanderski teaches a form of tallying for statistical purposes, it does not follow that one of skill would be lead to determine a score for each of one or more candidate paths" and "[select] one of the paths based on the score," absent any teaching to do so. In making this rejection, the Examiner has not cited any teaching in the art that would lead one of skill to score candidate paths. Wanderski is admittedly devoid of any such teaching. Wanderski describes counting the occurrence of attribute values for the purpose of determining which occurs most often and then using this most-frequent value as the default value for the attribute. This type of tallying has nothing to do with determining a

candidate path or selecting one node over another. The jump from counting attribute values to scoring candidate paths is not forecast, projected, suggested, or in any way hinted in Wanderski. If anything, the breadth of the leap from simple counting of attribute values to scoring candidate paths evidences an act of invention.

Moreover, the fact that the rejection makes the leap without any form of viable evidence or substantiation-- as required by law--- indicates that an excessive degree of hindsight reasoning is at work. The law requires credible evidentiary support in the form of a suggestion or motivation in the art as a safeguard against impermissible hindsight reasoning. Although the examiner tosses up the Wanderski teaching of compaction as sufficient to make the jump, but compaction is clearly not enough. Indeed, Wanderski already reports redundancy reduction-- "remov[al of] redundant information from element declarations and attribute declarations, as the primary means of compaction." See column 13, lines 38-40. This removal activity entails the relatively simplistic activity of looking for data duplication. It seems fair to conclude not only that looking for duplication in a set of nodes is a much different enterprise than scoring one or more candidate paths through the set of nodes, but that looking for duplication does not suggest the scoring.

In the absence of any viable evidence that a teaching to count attribute values for the purpose of identifying a default attribute would move one of skill to determine one or more scores for candidate paths through a set of nodes, applicant concludes that the Examiner has tacitly taken official notice of the contents of the art. As such, applicant requests respectfully, under MPEP 2144.03 and 37 CFR §1.104(d)(2), that the Examiner submit documentary evidence, in the form of an appropriate reference or a personal affidavit, supporting his proposed motivation for combination. Absent appropriate evidentiary support, applicant requests respectfully that the Examiner reconsider and withdraw the §103 rejections of claims 1-8 and 13-15.

With respect to claims 9 and 10, applicant submits respectfully that the Action fails to set forth a prima facie case of obviousness. For instance, the Action does not explain where in Wanderski one of skill would find a teaching to "generat[e] a mapping file from the document and the document type definition, with the mapping file comprising one or more nodes, each node representative of a possible mapping of an element of the document type definition to a

portion of the document." Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the §103 rejection of claims 9 and 10.

Response to §103 Rejections Based on Wanderski and Yamakawa

The Examiner rejected claim 33 under 35 U.S.C. §103(a) as being unpatentable over Wanderski in view of Yamakawa (U.S. Patent 5,907,851), specifically conceding that Wanderski omits a teaching of "providing a set of two or more DTDs, and selecting one for conversion," but asserting that Yamakawa "teaches document conversion utilizing preparation of a plurality of ..DTDs for switching and development of one or more DTDs (Yamakawa, column 22, lines 22-32, Figure 67.) Further, the Examiner argued that if would have been obvious to apply Yamakawa to Wanderski to provide "the benefit of predetermined DTD selection for eventual adherence to various established standards."

In response, applicant submits respectfully that the proposed motivation is not applicable to Wanderski. Wanderski reports "a method, system, and computer-readable code for ... creating an Extensible Markup Language, or XML dialect.. and then dynamically generating a document type definition for this XML dialect." (Column 1, lines 16-23.) As such, it appears that one of skill would view the provision and selection of multiple DTDs to be contrary to the teachings of Wanderski. Wanderski reports dynamic generation of customized DTDs; so, it would seem a step backward to resort to selection to a DTDs from a set of DTDs. Moreover, it's not all clear why one of skill would want to select from a set of DTDs, if a customized or tailored one were available.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the §103 rejection of claim 33.

CONCLUSION

In view of these remarks, applicant requests respectfully that the Examiner reconsider the application. Moreover, applicant invites the Examiner to telephone its patent counsel Eduardo Drake at (612) 349-9593 to resolve any issues that may delay allowance of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

MICHAEL S. ZAHARKIN

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 349-9593

Date 11 July 2006

By _____
Eduardo E. Drake
Reg. No. 40,594

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 11th day of July, 2006.

JONATHAN FERTAGUS
Name

_____
Signature